CLAIM 36

Applicant notes that claim 36, pending herein, is not included in the Restriction Requirement.

Claim 36 is directed to an oligonucleotide analog, and therefore should be included in Group II, as the Requirement is currently drawn.

Applicant respectfully requests that the Examiner make the above correction to the Requirement.

TRAVERSAL OF RESTRICTION REQUIREMENT

Applicant respectfully traverses the Restriction Requirement as between Groups I and IV, and as between Groups I and V, and as between Groups I and VI. Therefore, Applicant respectfully requests that Groups I and IV, or Groups I and V, or Groups I and VI be examined in the instant application.

This application is the U.S. national stage of International Patent Application No. PCT/US98/02007, in accordance with 35 U.S.C. §371. As stated in MPEP 201, national stage applications of international applications are similar to national applications, but there are differences. Among these differences is inapplicability of restriction practice to national stage applications. Restriction practice is applied to national applications, but unity of invention practice is applied to national stage applications (see, MPEP 201 and MPEP 1893.03(d)).

Lack of Unity Standard

When the U.S.Patent Office considers an international application **during the national stage**, restriction must be based on unity of invention, which is governed by PCT Rule 13 (see MPEP 1893.03(d); Caterpillar Tractor Co. v. Commissioner of Patents and Trademark, 650 F. Supp. 218, 31 USPQ 590 (E.D. Virginia, 1986); In re Caterpillar Tractor Co, 228 USPQ 77). In the Caterpillar cases it was ultimately held that the language in Rule 13.1 "specially adapted" is not to be interpreted as meaning that the process of manufacture can only be used to manufacture the product because this interpretation is in

conflict with the PCT Rule, which provides that no national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided in the Treaty (Article 27 of the PCT). Thus, the U.S. Patent Office cannot impose requirements that differ from those provided in the Treaty. Since restriction practice differs from and is more restrictive than unity of invention, the unity of invention rules must govern.

Therefore, it is respectfully submitted, and it appears that the Office has acknowledged, that the rules of unity of invention (PCT Rule 13.1 and 37 C.F.R. §1.475) apply to this application. Rule 13.1 requires that an international application shall relate to one invention only or to a **group of inventions so linked as to form a single general inventive concept.**

PCT Rule 13

It is respectfully submitted that Groups I and IV, and Groups I and V, and Groups I and VI, relate to a product, a process for the manufacture of said product, and a use of the said product, and therefore do not lack unity of invention under PCT Rule 13. It is therefore respectfully requested that Groups I and IV, or Groups I and V, or Groups I and VI, be examined in the instant application.

Groups I and IV

Group I is directed to a composition and a method of preparing the composition. Group IV is directed to a method of purification using the composition of claim 44. Claim 44 is in Group I. Such groups of claims do not lack unity of invention under PCT Rules 13.1 and 13.2. See 37 CFR §1.475(b):

> An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:
> ...
> (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product...

The claims of Group IV are directed to a use of the composition of Group I (a method of purification), and the claims of Group I are directed to a product and a process specially adapted for the manufacture of the product (a process for preparing the composition of claim 1). Such Groups of claims do not lack unity of invention, and therefore should be examined in one application.

Applicant respectfully requests reconsideration of the lack of unity objection as between Groups I and IV. In view of Applicant's election of Group I herein, it is respectfully requested that the claims of Groups I and IV, *i.e.*, claims 1-19, 44-49 and 53-56, be examined in the instant application.

Groups I and V

Group I is directed to a composition and a method of preparing the composition. Group V is directed to a method of sequencing using the composition of claim 44. Claim 44 is in Group I. Such groups of claims do not lack unity of invention under PCT Rules 13.1 and 13.2. See 37 CFR §1.475(b):

> An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:
> ...
> (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product...

The claim of Group V is directed to a use of the composition of Group I (a method of sequencing), and the claims of Group I are directed to a product and a process specially adapted for the manufacture of the product (a process for preparing the composition of claim 1). Such Groups of claims do not lack unity of invention, and therefore should be examined in one application.

Applicant respectfully requests reconsideration of the lack of unity objection as between Groups I and V. In view of Applicant's election of Group I herein, it is respectfully requested that the claims of Groups I and V, *i.e.*, claims 1-19, 44-47, 50 and 53-56, be examined in the instant application.

Groups I and VI

Group I is directed to a composition and a method of preparing the composition. Group VI is directed to a method of genetic or expression profiling using the composition of claim 44. Claim 44 is in Group I. Such groups of claims do not lack unity of invention under PCT Rules 13.1 and 13.2. See 37 CFR §1.475(b):

> An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:
> ...
> (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product...

The claim of Group VI is directed to a use of the composition of Group I (a method of genetic or expression profiling), and the claims of Group I are directed to a product and a process specially adapted for the manufacture of the product (a process for preparing the composition of claim 1). Such Groups of claims do not lack unity of invention, and therefore should be examined in one application.

Applicant respectfully requests reconsideration of the lack of unity objection as between Groups I and VI. In view of Applicant's election of Group I herein, it is respectfully requested that the claims of Groups I and VI, *i.e.*, claims 1-19, 44-47, 51 and 53-56, be examined in the instant application.

* * *

In view of the above, reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,
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